

REMARKS

Claims 15-18 and 24-27 were pending. Claims 15-18 and 24-27 have not been amended. Claims 28-31 are new. No new matter has been added.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 15-18 and 24-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Quayle et al. (U.S. Patent No. 6,694,464) in view of Kiefer et al. (*Deterministic BIST with Multiple Scan Chains*), and Claims 15-18 and 24-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sample et al. (U.S. Patent No. 6,377,912) in view of Kiefer et al. Applicant respectfully traverses these rejections.

Applicant notes that, at the time the claimed invention was made, the claimed invention and Quayle and Sample were owned by, or were subject to an obligation of assignment to, the same person. An assignment for Quayle is recorded in the Patent and Trademark Office at Reel/Frame: 011513/0513. An assignment for Sample is recorded in the Patent and Trademark Office at Reel/Frame: 008605/0931.

Specifically, at the time the claimed invention was made, the claimed invention was owned by, or was subject to an obligation of assignment to, Cadence Design Systems, Inc. Furthermore, at the time the claimed invention was made, Quayle and Sample were owned by, or subject to an obligation of assignment to, Quickturn Design Systems, Inc., a wholly owned subsidiary of Cadence Design Systems, Inc.

As this Statement of Common Ownership disqualifies Quayle and Sample as prior art under 35 U.S.C. 103, withdrawal of the rejection of claims 15-18 and 24-27 is respectfully requested.

Accordingly, because Kiefer et al. does not teach or suggest the claimed invention as a whole, Applicant respectfully submits that the present application is in condition for allowance and such allowance is respectfully requested.

New Claims

Claims 28-31 are method claims corresponding to claims 15-18 as well as 24-27. Thus, they are allowable for at least the above reasons.

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. 50-2518, referencing billing number **7034222001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. 50-2518, referencing billing number **7034222001**.

Respectfully submitted,
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